

REMARKS

This Response is made in reply to the Official Action mailed May 1, 2000.

Reconsideration and withdrawal of the rejections of this application are respectfully requested in view of the remarks herewith.

Claims 10 to 23 are pending. No new matter is added.

Any additional fees occasioned by this paper, or any overpayment therein, may be charged or credited to Deposit Account No. 50-0320.

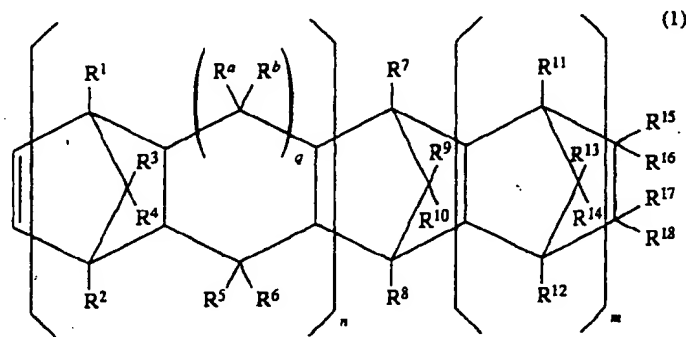
Claims 10 to 14, 17 to 19 and 20 to 23 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Hirose et al., U.S. Patent No.: 5,532,030 ("Hirose"). In addition, claims 15 and 16 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Hirose et al., U.S. Patent No.: 5,532,030 ("Hirose"). (Office Action, at 2 to 6).

These rejections will be addressed collectively. It is submitted that these rejections are unwarranted and reconsideration and withdrawal of same is respectfully requested.

The present invention teaches a mono- or multilayer film, where the film consists of a cycloolefin copolymer or mixtures of cycloolefin copolymers and one or more thermoplastics, and where, at 85% relative humidity and a temperature of about 23⁰C, the film has a water vapor permeation of $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$, a puncture resistance of $\leq 300 \text{ N/mm}$ and a thickness of $\leq 100 \mu\text{m}$.

Hirose, on the other hand relates to A polyolefin multilayer laminate in which a first layer (A) made of a cycloolefin-based resin, such as an ethylene/cycloolefin random copolymer resulting from copolymerization of ethylene and a cycloolefin represented by the formula (1) given below, or a cycloolefin-based resin blend and a second layer (B) made of an olefin (co)polymer or a composition containing it are laminated. This laminate can be used as a

packaging material which is superior in the interlayer adhesion, shapability, moistureproof property, transparency, flexibility, easiness of hand-cutting, heat-sealability and dead-hold property. Formula (1)



in which n and q are 0 or 1, m is 0 or any positive integer, R^1 - R^{18} , and R^a and R^b denote each H, a halogen atom or a hydrocarbon group, wherein R^{15} - R^{18} may form, by combining with each other, a monocyclic or polycyclic ring, which may have double bond(s), and wherein R^{15} - R^{16} may have terminal-located alkylidene group.

Thus, Hirose relates to a polyolefin multilayer laminate in which at least one layer consists of a cycloolefin-based resin (*See* Abstract of the Hirose patent). Furthermore mono- or biaxial stretching of such films as well as use of such films as a packaging material is provided.

To the contrary, claim 20 of the instant patent application claims a mono- or multilayer film comprising a cycloolefin polymer and (emphasis added) possessing a specific set of properties (water permeation, puncture resistance and thickness). In particular, the puncture resistance of the films is obtained by a selected processing of the film; such procedure and films with such properties are neither taught nor disclosed from the Hirose et al. patent. The Examiner's attention is respectfully invited to review page 11, lines 11 to 14 of the specification, which specifically explains the characteristics of the COC base as:

...the COC base film and the backing film have similar action as water vapor barriers, the thickness of the backing film cannot be reduced at will in order to adjust its puncture resistance. This implies a thickness for COC-based backing films in the range from 20 to 150 μm .

In addition, the Examiner is further invited to review the originally filed specification, page 8, line 8 to page 10, line 7 which provides a list of transition metal compounds in accordance with the present invention, page 13, lines 15 to 29 which specifically teaches how the film in accordance with the present invention can be simultaneously biaxially stretched and the properties of the film processed as prescribed in Example 2 and finally, page 15, lines 18 to 35 under Examples 8 to 10 which listed the specific properties in directions of stretching. IF the Examiner considers necessary, Applicants will submit a Declaration by the inventors to substantiate this position.

Conversely, Hirose only generally mentions that its films can be stretched mono- or biaxially (*See* Col. 34, lines.42-45). Stretching of films is generally known in the art. Thus Hirose does not disclose any more than what one skilled in the art would expect to do after preparation of the films. But the specific combination of properties and the specific manner of treatment of the instantly claimed films is neither taught nor disclosed in Hirose. Accordingly, the present invention could not possibly have been anticipated by or obvious in view of Hirose.

The films according to the present invention are preferably used for blister packs, and especially preferred as a backing film for blister packs (*See* specification page 1, lines 7-10). For this application the film must be easy to puncture (*See* specification page 3, lines.3-5). In order to achieve the desired puncture resistance (as claimed and defined in claim 20) a specific orientation has to be given to the films (*See* specification page 11, lines 18-24). Moreover, the mechanical properties of the film have to be selected properly in order to ensure reliable processing (*See* comp. page 11, lines 24-26). In addition, Hirose only relates to multilayer films whereas the present invention teaches and claims both mono- and multilayer films.

According to the disclosure in the present application, if the stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. *See again*, Examples 2 and 9 to 10. This requirement is lacking in Hirose's disclosure. Accordingly, the present invention is clearly patentable over Hirose.

Consequently, the present invention is neither anticipated by nor obvious over Hirose.

A prior art reference must contain all of the elements of the claimed invention to be said to properly "anticipate" the claimed invention. Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q.2d, 1766 (Fed. Cir. 1987). To constitute anticipation, all material elements of a claim must be found in one prior art source. In re Marshall, 198 U.S.P.A. 344 (C.C.P.A. 1978); In re Kalm, 154 U.S.P.Q. 10 (C.C.P.A. 1967).

Hirose does not disclose a mono layer film comprising a cycloolefin polymer and possessing a specific set of properties such as water permeation, puncture resistance and thickness, as claimed and disclosed in the present invention. In particular, the puncture resistance in accordance with the present invention is obtained by a selected processing of the film which are lacking in Hirose.

Accordingly, the Office Action failed to meet its burden in showing that Hirose contains every limitation of rejected claims 10 to 14, 17 to 19 and 20 to 23.

In view of the foregoing, Applicants respectfully submit that Hirose does not contain all of the elements of the claimed invention and thus fail to anticipate the claimed invention. It is submitted that the rejection under 35 U.S.C. 102(b), based on Hirose is unwarranted and should be withdrawn.

Applicants likewise maintain that the rejection of claims 15 and 16 under 35 U.S.C. § 103(a), based on Hirose, is unwarranted. Despite the statements in the Official Action,

it is urged that one skilled in the art, using Hirose, would not be led to Applicants' claimed invention.

There can be no obviousness when the reference teaches away from the invention at hand. In re Fine, 5 U.S.P.Q.2d 1596,1599 (Fed. Cir. 1988)(citing W. L. Gore & Assoc. v. Garlock, Inc., 220 U.S.P.Q. 303,311 (Fed. Cir. 1983)).

Furthermore, Hirose only relates to multilayer films whereas the present invention teaches and claims a mono- or a multilayer film.

In this regard, whether a particular product or method might be "obvious to try" is not a legitimate test of patentability. In re Fine, 5 U.S.P.Q.2d 1596, 1599 (Fed.Cir. 1988); Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed.Cir. 1986); Ex parte Old, 229 U.S.P.Q. 196, 200 (PTO Bd. App. & Int. 1985). "Obvious to try" is not the standard.

Consequently, the Section 103 rejection cannot stand. The present invention is neither taught nor suggested by Hirose and Hirose fails to provide either the desirability or modification required by Fine.

Applicants therefore submit that the rejection of claim 15 under 35 U.S.C. § 103(a) based on Hirose, is unwarranted and should be withdrawn.

In view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. Section 102(b) and Section 103 are respectfully requested.

The Examiner is thanked for withdrawing the provisional double patenting rejection of claims 9 to 14 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 5 of copending application No. 08/994,863. (Office Action, at 6).

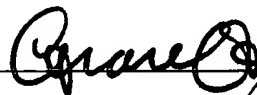
Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a)(1), Applicants hereby request that the term for reply to the May 1, 2000 Office Action be extended one month, i.e., up to and including September 1, 2000. A check for \$110.00 is enclosed herewith.

Any additional fee occasioned by this paper and the petition for extension of time herein accompanying this paper, or any overpayment in those fees, may be charged or credited to Deposit Account No. 50-0320.

In view of the remarks herewith, the present application is in condition for allowance. Early and favorable reconsideration and prompt issuance of a Notice of Allowance are earnestly solicited. If any issue remains as an impediment to allowance, an interview is respectfully requested and the Examiner is further respectfully requested to contact the undersigned by telephone to arrange a mutually convenient time and manner for the interview.

Respectfully submitted,

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